



UNITED STATES PATENT AND TRADEMARK OFFICE

37

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/928,108 | 08/10/2001 | Lachlan Everett Hall | NP1003A-US | 7453 |
| 24011 | 7590 | 01/25/2006 | EXAMINER | |
| SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA | | | COPPINS, JANET L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1626 | |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,108

Applicant(s)

HALL ET AL.

Examiner

Janet L. Coppins

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/693,301.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-6 are pending in the instant application.

Information Disclosure Statement

2. Applicants' Information Disclosure Statement(s), submitted February 4, 2005 and October 24, 2005, have been considered by the Examiner. Please refer to Applicants' copies of the PTO-1449 forms submitted herewith.

Election/Restrictions

3. The Examiner notes with appreciation Applicants' provisional election with traverse of Group I, claims 1 and 4, and the specific compound 3 on page 88, in the response of October 24, 2005. However, Applicants' amendatory changes to the claims render the restriction moot between Groups I and II; therefore the elected Group I now contains claims 1-4 and is drawn to an infrared dye composition, classified in class 430, subclass 616+. Group II, claims 5 and 6, are currently withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R. 1. 142(b) as drawn to non-elected subject matter (a solvent-based ink composition, class 106, subclass 31.13+).
4. Applicants' traversal is based on the allegations that a) all claims share a common utility as being infrared absorbing dyes and ink compositions comprising the same, and b) that co-pending U.S. Application 09/927,685 was not restricted, thus the instant claims should likewise not be restricted.

The Examiner respectfully disagrees. Regarding argument a) above, Groups I and II are directed to two distinct compositions that do not necessarily have the same utility. The infrared dye products of Group I are deemed to be useful to make other than ink compositions, for example, since infrared dyes are present in thermoplastics as well as epoxy resins. Regarding

Art Unit: 1626

argument b) above, each case is examined on its own merits, regardless of what another examiner did previously. Therefore, Group II remains withdrawn from consideration.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 1 recites the variables “m” and “n” as “the number of fused 6-membered aromatic rings connected to each side of the central moiety...” yet fails to set a range for the values of said variables. Therefore the parameters of the molecule of formula 1 are unclear since Applicants have not defined the upper and lower limits of “m” and “n” within the claims, nor within the specification. Clarification is requested.

(b) Claim 3 recites the limitation, “wherein bulky substituents are utilized.” This claim is indefinite because it is unclear what is meant by “bulky substituents” from the claim itself. It is also unclear what is meant by the term “utilized” since method steps have not been included. The Examiner recommends the following language, “...wherein Q₁ and Q₂ are optionally substituted by the bulky substituents X, Y, and Z,” for example.

(c) Claim 4 recites the limitation "compound" in line 1. There is insufficient antecedent basis for this limitation in the claim, since claim 1 is drafted in terms of an infrared dye composition and not just the compound itself. It is also unclear how and where the polar group substituents are “utilized” since no method steps are provided. Furthermore, the phrase

Art Unit: 1626

"such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The Examiner recommends the following language, "...wherein Q₁ and Q₂ are optionally substituted by one or more of the polar groups -SO₃H, -NH₂, and -CN."

(d) Claims 2, 3, and 4 are also rejected under 35 U.S.C. 112, second paragraph, as being dependent on base claims rejected under 35 U.S.C. 112, 2nd paragraph.

Conclusion

7. In conclusion, claims 1-6 are pending, claims 5 and 6 are currently withdrawn from examination, and claims 1-4 stand rejected.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/928,108

Page 5

Art Unit: 1626

Janet L. Coppins
January 19, 2006

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER

for Kamal Saeed
Joseph K. McKane
SPE, Art Unit 1626